

## Remarks

The numbered paragraphs of the office action are responded to through the corresponding numbered paragraphs below. The applicant has addressed each issue in turn and, for clarity, has provided a heading for each issue.

### *Claim Rejections - 35 U.S.C. § 103*

1. The Examiner provided the citation to "35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action." The Examiner also stated that the "examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made." The applicant confirms that all inventors are and were employees of Helius Development Corporation at the time the invention was made and have executed assignments of all their rights to Helius Development Corporation. The subject matter of the claims is therefore commonly owned.

2. The Examiner rejected claims 41-73 "under 35 U.S.C. § 103(a) as being unpatentable over Dillon, U.S. Pat. No. 5,995,726." The Examiner concedes that "Dillon does not explicitly teach a local area network (LAN) with a plurality of clients (including hardware and software) in communication with the server." Nevertheless, the Examiner states "[h]owever, it would have been obvious to one of ordinary skill in the art *at the time of the invention was made* to be motivated by disclosure of the Internet 128 by Dillon to include a client-server connected to a LAN with a plurality of clients because it is old and known in the art to use LAN or WAN with a plurality of clients to connect to the Internet." [*Emphasis added*]. The applicant appreciates the Examiner's consideration

but continues to maintain that to the applicant's best information, the Examiner is in error when he states "a client-server connected to a LAN with a plurality of clients because it is old and known in the art to use LAN or WAN with a plurality of clients to connect to the Internet." In paragraph 3 - *Response to Arguments* - the Examiner provides his only basis for this statement, when he cites to Willis et al. (U.S. Pat. No. 6,385,647) to show "the use of LAN or WAN with a plurality of clients to connect to the Internet." The applicant notes that Willis et al. is not prior art under 35 U.S.C. § 102/103. Namely, Willis et al. was filed on August 18, 1997 and published (issued as a patent) on May 7, 2002. The present application claims priority to U.S. Patent No. 6,205,473, which was filed on October 3, 1997 and which issued as a patent on March 20, 2001. Accordingly, the present application's parent case actually issued before Willis et al. Willis et al. therefore was clearly not published before the invention thereof by the applicant (35 U.S.C. § 102(a)); was not patented or described in a printed publication more than one year prior to the priority date of the application (35 U.S.C. § 102(b)); and since applicant can show if necessary that applicant invented the invention described in the present application prior to filing date of Willis et al. (35 U.S.C. § 103(e)), therefore Willis et al. is not prior art to the present application and cannot be properly combined with Dillon to support a § 103 rejection, because Willis et al. does *not* show that "it would have been obvious to one of ordinary skill in the art *at the time of the invention was made* to be motivated by disclosure of the Internet 128 by Dillon to include a client-server connected to a LAN with a plurality of clients because it is old and known in the art to use LAN or WAN with a plurality of clients to connect to the Internet" as asserted by the Examiner. The applicant would be pleased to swear behind Willis et al. as a reference, but does not

believes such is appropriate at this point of prosecution of this application because the Examiner did not actually use the Willis et al. reference as part of a combination of references to support the § 103 rejections. Accordingly, since the Examiner has provided no basis for his assertion that "a client-server connected to a LAN with a plurality of clients because it is old and known in the art to use LAN or WAN with a plurality of clients to connect to the Internet" prior the priority date of this application, the applicant respectfully maintains that the Examiner has not made his *prima facie* case for obviousness. Therefore, the applicant respectfully asserts that each independent claim (claims 41, 59, 70, 71, 72 and 73) include at least one element not disclosed or suggested in the cited or any other known prior art reference. Since each dependent claim naturally includes the limitations of the claims on which it depends, the applicant believes that each claim as presently presented is patentable over all known prior art. Accordingly, the applicant respectfully requests reconsideration and withdrawal rejections of this action.

#### *Response to Arguments*

3. The Examiner indicated that "Applicant's arguments have been fully considered but are not persuasive". The applicant appreciates the Examiner's consideration but maintains that, to the applicant's best information, the Examiner is in error when he states "a client-server connected to a LAN with a plurality of clients because it is old and known in the art to use LAN or WAN with a plurality of clients to connect to the Internet." Also as noted above the applicant respectfully disagrees with the Examiner with regard to the materiality of the Willis et al. reference. Since the Willis et al. reference does not qualify as prior art with respect to this application, the applicant does not feel that it is necessary to comment on the content of the Willis et al. reference. The

applicant also maintains its argument that there is not suggestion to combine the Dillon reference with a mere impression of the Examiner unsupported by any known prior art reference. As previously noted, the applicant agrees that such systems as the Examiner states are "old and known in the art" are well known at this time, but wishes to remind the Examiner that such systems were not known, described or understood at the time of filing the parent to this Continuation application. This application claims priority to U.S. Patent Application No. 08943,544, filed on October 3, 1997, which subsequently issued as U.S. Patent No. 6,205,473. Prior to the priority date of this application, such systems as described by the Examiner as "old and known in the art" were not known or in use. The applicant respectfully believes that the Examiner is using current technology as a basis for a purely hindsight reconstruction to establish an obviousness determination. The applicant has pointed out at least one element of each claim not found in the prior art, accordingly the applicant believes that specific claimed limitations have been identified that define a clearly patentable distinction over the prior art. Namely, the Applicant has previously requested that claims 41, 59, 70, 71, 72 and 73, the independent claims, on which claims 42-58, and 60-69 depend, be amended to more clearly point out that applicant's invention includes a "plurality of client computers" connected to a "local area network" such that the "server computer" routes download data to the plurality of computers. Dillon appears to disclose and teach a single computer with a one-to-one communications system from an information provider to a single computer. Applicant's invention claims a plurality of client computers connected to a local area network that is also connected to a server computer to achieve a one-to-many or many-to-many communication system. Thus, the server computer of applicant's invention accomplishes

the routing to particular computers on the local area network. The Dillon reference could not be combined with a local area network to accomplish applicant's invention because Dillon provides no server computer and provides no routing capability. Thus, the Dillon reference does not make applicant's invention obvious. Because Dillon is for a single computer and because it provides no routing capability by a server computer, there is no suggestion or incentive in the references that would have motivated one of skill in the art to modify or combine the references to arrive at the claimed invention. Moreover, with no server computer and no routing capability in Dillon, Dillon would not work across a local area network and thus one of skill in the art would not have had a reasonable expectation of success at the time the invention was made regarding the applicant's invention. The applicant believes that the previously requested amendments to these independent claims and these remarks are fully responsive to the rejection of this paragraph.

Also, while the Examiner states that "Dillon does not explicitly teach a local area network (LAN) with a plurality of clients (including hardware and software) in communication with the server. However, it would have been obvious to one of ordinary skill at the time the invention was made to be motivated by the disclosure of the Internet 128 by Dillon to include a client-server connected to a LAN with a plurality of clients because it is old and known in the art to use LAN or WAN with a plurality of clients to connect to the Internet", the applicant respectfully disagrees. As noted above, the applicant believes that the Examiner is in error when he states "a client-server connected to a LAN with a plurality of clients because it is old and known in the art to use LAN or WAN with a plurality of clients to connect to the Internet." The Examiner provides no

"prior art" reference for this assertion, or any support for this conclusion. The applicant agrees that such systems are well known at this time, but wishes to remind the Examiner that such systems were not known, described or understood at the time of filing the parent to this Continuation application. This application claims priority to U.S. Patent Application No. 08943,544, filed on October 3, 1997, which subsequently issued as U.S. Patent No. 6,205,473. Prior to the priority date of this application, such systems as described by the Examiner as "old and known in the art" were not known or in use. The applicant respectfully believes that the Examiner is using current technology as a basis for a purely hindsight reconstruction to establish an obviousness determination. Accordingly, since the Examiner has provided no basis for his assertion that "a client-server connected to a LAN with a plurality of clients because it is old and known in the art to use LAN or WAN with a plurality of clients to connect to the Internet" prior the priority date of this application, the applicant respectfully maintains that the Examiner has not made his *prima facie* case for obviousness. Accordingly, the applicant respectfully requests reconsideration and withdrawal of this rejection.

### *Conclusion*

4. The Examiner indicated that a shortened statutory period for response is set and that extensions may be obtained under the provisions of 37 CFR 1.136(a). The applicant is submitting a petition for extension of time and fee for an extension of time under the provisions of 37 CFR 1.136(a) with this response. The applicant believes that this submission, being made within the permitted extension period is fully responsive and permits this application to continue prosecution.

5. The Examiner provided information concerning communication with the Examiner on this case. The applicant appreciates the Examiner's willingness to communicate and progress this case.

In view of the foregoing, and in summary, Applicant believes that all issues and points of the Examiner's Office Action have been addressed and that the independent claims and all claims dependent on this claims are patentable over the prior art. Reconsideration of the application and allowance of this application is respectfully requested.

Respectfully submitted this 17th day of June, 2004.



Lloyd W. Sadler, Reg. No. 40,154  
PARSONS BEHLE & LATIMER  
201 South Main Street, Suite 1800  
Salt Lake City, Utah 84111  
Telephone: (801) 532-1234  
Facsimile: (801) 536-6111